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Illuminating European Trade Marks

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Abstract

An analysis of recent developments in European trade mark law and a consideration of the future for trade marks and harmonisation of trade mark law in Europe, with particular reference to less conventional trade marks.

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1. What is a trade mark

Brands are of great commercial importance and value. Consider the power of the names “Nike”, (www.nike.com) “Google” (www.google.com) and “Starbucks” (www.starbucks.com) to the consumer: the consumer is likely to want to buy goods or use services bearing those names, and if so, is will not be satisfied with sportswear, search engines and coffee under another name, irrespective of the quality of the product itself. It is not surprising, therefore, that such brands are among the most valuable of today’s business assets.¹

While such brands tend to be developed initially through a combination of product innovation, quality service and careful marketing and advertising, trade mark registration plays a significant part in maintaining and protecting the value of the brand, by preventing the establishment of competitors using another brand which may diminish its distinctiveness. Acquiring a registered trade mark means that the brand owner has the right to prevent others using the same or similar brand, in relation to the same or similar goods or services (say “Googly” for computer hardware).² Importantly, this could be done once the registration has been acquired: it would not matter that the brand was not yet particularly established, or the business had not been launched. For the most well known brands, it is also often possible to prevent use in relation to different goods or services (say “Nike” for anything).³

Although court proceedings are sometimes necessary to enforce a trade mark, frequently simply having the registration, and complaining about offending conduct, can lead to a satisfactory result. With trade marks therefore conferring significant power, the basis on which they are obtained is important.

Trade marks are granted by national trade mark registries, with international brand owners holding many registrations for the same trade mark. Clearly, this could give rise to national differences in approach, however international treaties⁴ prescribe the basic principles to be followed by courts and trade mark registries, aiming for an element of consistency.

2. Trade Marks in the European Community

That said, a fundamental principle of the European Community⁵ is to remove barriers to trade between member states. As trade marks are national rights, and as branded goods move frequently around the Community, any differences between member

¹ See Interbrand “Brand of the Year” Survey 2003

² Although the laws of different countries differ (see below), this is usually subject to establishing consumer confusion.

³ usually subject to establishing damage to the reputation or value of the trade mark.

⁴ such as the Paris Convention and the WTO TRIPS agreement

⁵ Established by the Treaty of Rome 1957, amended by the Treaty of Amsterdam 1999. Present member states are Belgium, Germany, France, Italy, Luxemburg, the Netherlands, Denmark, Ireland, the United Kingdom, Greece, Spain, Portugal, Austria, Finland and Sweden. 10 new countries, mainly from Eastern Europe, will join in 2004.

states in procedures and laws for the grant of trade marks and their enforcement (for example, if one country always favoured the local manufacturer, even if a large multinational had a registered trade mark in the country – say favouring “Channel” in the South of England, over “Chanel”, or if some countries applied different standards of trade mark infringement) could be a barrier to free trade. Such concerns resulted in the Trade Marks Harmonisation Directive (“the Directive”),⁶ setting out the trade mark law and procedure to be adopted by member states.

The Directive led to significant changes in the trade mark laws of some member states.⁷ One of the main issues was what could now be registered. The Directive provides that to be capable of registration, a sign must be “capable of being represented graphically”,⁸ not devoid of distinctive character⁹ and “capable of distinguishing goods or services of one undertaking from those of another”.¹⁰ This raised new possibilities, and questions, some of which are considered below.

Further, while the Directive aimed to remove differences between national trade mark laws, the fact remained that member states granted their own trade marks. There was the potential, therefore, for dispute to arise when branded goods from say France, (for example NON NI chocolate, with NON NI being a French registered trade mark) entered the Spanish market, and competed with similar goods bearing a similar brand, (say NONNON confectionery) from a local manufacturer who owned a Spanish registered trade mark. Could the Spanish manufacturer complain? What would happen if they tried to sell their product in France?

With a view to reducing such conflicts in the future, a Community Trade Mark¹¹ was also created. By this system, brand owners make one central application to the Community Trade Mark Office (OHIM) in Alicante, Spain. If a trade mark is granted, then the owner has one registration for the whole of the European Community.¹² The substantive law of the Community Trade Mark (in particular, the basic criteria for registration¹³) is similar to that of the Directive. As will be seen below, difficulties have also been encountered in the application of these.¹⁴

⁶ 89/104/EEC

⁷ examples were the UK Trade Marks Act 1994 and the amendment to the Uniform Benelux Law on Trade Marks of 1993.

⁸ article 2

⁹ article 3

¹⁰ article 2

¹¹ Council Regulation EC 40/94 of December 20, 1993 on the Community trade mark (“**the Regulation**”). This system exists in parallel with national systems.

¹² Practical issues were encountered at the outset, and remain, in relation to situations such as the example above: what if the same or similar trade mark was genuinely well established in different countries by different brand owners.

¹³ see the Regulation, article 4 and article 7

¹⁴ Note that infringement actions are raised in designated national courts, articles 91-93 of the Regulation, as there is no central CTM Court.

3. New opportunities for brand owners?

The simple requirement for registration of “graphic representation” led to new interest in trade mark applications. In the United Kingdom, for example, it had not been possible previously to register shapes (including the well known shape of the “Coca-Cola” bottle), sounds, or smells.¹⁵ Trade marks had traditionally focussed on words, often in a stylised script [such as the “Esso” trade mark, webdb4.patent.gov.uk/tm/number?detailsrequested=C&trademark=578906] to attract consumer’s attention.

The possibility of seeking trade mark protection for items of existing commercial importance (like the “Coca-Cola” bottle) was of great appeal for business. If a registration could be obtained, then the owner would not be required to rely on other forms of protection, such as copyright, passing off,¹⁶ unfair competition,¹⁷ designs and patents. This had significant advantages: if similar packaging was used by a competitor, but had been developed independently, then it would not be possible for the brand owner to rely on copyright or unregistered design right infringement;¹⁸ if a new business was launched and a short time later a competing business developed a similar or identical logo, the first business may not have established the necessary reputation or market presence to be able to found an action in passing off or unfair competition. In addition, provided renewal fees are paid, trade mark protection may be perpetual, unlike the other rights considered above.¹⁹

4. New world?

The European (and indeed global) business community did indeed respond to the opportunities of the new legislation. In addition to filing applications for existing distinguishing features, many innovative trade marks were developed and applications filed, both at national registries and for the new CTM. Examples of United Kingdom

¹⁵ More detailed examples of trade marks which could not be registered are found at 249 of J Philips and A Firth, *“Introduction to Intellectual Property Law”* 2nd edn, 1990, Butterworths, London

¹⁶ in the United Kingdom

¹⁷ in some other member states

¹⁸ if the latter right is available (United Kingdom right (s 213 Copyright Designs and Patents Act 1988)) – although note the recent introduction of the European Unregistered Design, (Council Regulation (6/2002), Regulation on the Community Design - 12 December 2001). These rights essentially depend on copying. Depending on the packaging, eg an unusual bottle or a novel box, it may be possible to rely on registered designs or patents, which do not depend on copying, simply on the extent of similarity. However, obtaining and enforcing such rights is generally more costly than it is in respect of trade marks – for example, there is the need to establish novelty to obtain patents and registered designs; and infringement actions will likely be met with a counterclaim for revocation, which will involve analysis of prior art.

¹⁹ In the European Community, the copyright term is author’s life plus 70 years (s12 UK Copyright Designs and Patents Act 1988, EC Directive on Duration 93/98); the patent term is 20 years (see section 25 UK Patents Act 1977 (there is no EC patent legislation on this issue, but most member states are signatories to the European Patent Convention, which requires that the patent term in member states is 20 years – article 63); at the time design protection differed throughout the European Community – in the UK the term under s8 Registered Design Act 1949 was up to 25 years.

applications are “The Sound of A Dog Barking”; a musical stave showing a jingle; “The Strong Smell of Bitter Beer”; and the gesture of tapping the side of one’s nose.²⁰

However, a review of recent trade mark decisions of the European Community courts²¹ shows that disputes are continuing, between competing brand owners and between brand owners and national registries, as to what is in fact now capable of registration as a trade mark. Areas being considered include smells, sounds, shapes, and surnames, involving questions as to meaning of the terms “graphic representation” and “devoid of distinctive character”.

Although, as noted above, comparatively few applications for smells, sounds and shapes are filed, it is important for these questions to be clarified. As consumers and the commercial world become increasingly sophisticated and aware of brands, a key business strategy is innovative brand development – a simple word in stylised script may be considered to no longer suffice. These cases suggest, however, that before unusual new brands are developed, it should be ensured that they will in fact be capable of receiving trade mark protection. In respect of surnames, there are concerns as to the unjustified reservation to one trader of a name which others may be properly entitled to use – see, for example, perpetual complaints by McDonalds about cafes owned by Mrs McDonald (usually met by public outcry).

5. Recent cases

5.1 Smells

Most would agree that smells are distinctive: but can they be represented graphically? Would we all agree exactly how rotten eggs smell, much less how to prepare a trade mark application for the smell? In addition, smells are highly subjective – the smell of freshly brewed coffee is appealing to many, but may invoke an extreme negative reaction in some. When it is considered that registering a smell means that that smell or in some circumstances a similar smell cannot be used by others in respect of the same or similar goods or services, the need for clarity in defining the scope of protection is evident. From this perspective, does the “Strong Smell of Beer” referred to above indeed suffice?

In the light of this, the decision of the ECJ in *Sieckmann*²² is revealing. An application was filed in Germany for a “balsamically fruity scent with a hint of

²⁰ Examples taken from <www.itma.org.uk/trade-marks> (accessed 22 January 2004). The statistics for the CTM, however, reveal that the vast majority of CTM applications are still for more conventional trade marks. As at 30 September 1993, 0.87% of all CTM applications were for 3 dimensional shapes; 0.01% were for sounds; and 0.00% (to two decimal places - 6 applications in total) were for smells - <www.european-patent-office.org/epidos/conf/eac2003/pdf/pres/lopezderego.pdf> (accessed 22 January 2004).

²¹ The Court of Justice (“ECJ”) and Court of First Instance (“CFI”). Actions cannot be raised in the ECJ. Its function is to determine Community law, but the application of that law is for national courts. Questions of law are referred to the ECJ from national courts, including questions of the interpretation of the Regulation or the Directive. This is because trade mark infringement actions based on national laws implementing the Directive, or on the Regulation, will be raised in national courts. Actions can be raised in the CFI, and these include actions by those refused a trade mark by OHIM. An appeal lies from the CFI to the ECJ.

²² C-273/00 [2002] ECR I-11737

cinnamon” for various services. In addition to providing this verbal description, Sieckmann also provided the chemical formula which created the smell and a sample of the smell. The dispute as to whether these, or any of them, constituted “graphic representation” was ultimately referred to the ECJ. The ECJ held that the sample and description were inadequate as they were not sufficiently precise; the formula was not sufficient as few would actually know, from reading the formula, what it meant; and the combination was also unsatisfactory.

The ECJ did hold that smells could be registered as trade marks, even though the smell was not in itself capable of being perceived visually, provided it could be represented graphically. This could be by means of images, lines or characters, and should be clear, precise, self-contained, easily accessible, intelligible, durable and objective. In the light of the introductory comments above, it is apparent that it will be difficult to apply this test to smells, particularly with the need for the representation to be “intelligible”, as this may remove more scientific or technically based means of description.²³ It remains to be seen how many further applications will be made for smells.

That said, this may not be a significant problem. As mentioned above, a key aim of trade mark protection is to be able to enforce the trade mark against competitors and protect consumers from confusion as to the source of the products. Given the subjective and ephemeral nature of smells, query whether it is likely that many trade marks for smells would actually be the subject of infringement proceedings.

5.2 Sounds

Ask a family member to sing the same piece of music as you, or to impersonate an animal, and it is apparent that we do not all interpret or produce sounds in the same way. Add in regional or national differences and this increases. The issue of sound marks was considered in *Shield Mark BV v Joost Kis h.o.d.n Memex*,²⁴ the Hoge Raad of the Netherlands having referred to the ECJ questions regarding graphic representation and whether, under the Directive, a sound or noise could be registered as a trade mark.²⁵

Shield had Benelux²⁶ trade mark registrations for the sound of a cock crowing. The application represented the sound by the written description of “a cockcrow” and also as “Kukelekuuu” (how it was said that a cockcrow sounded in Dutch).

Shield also had a registration for the first 9 notes of Beethoven’s “Fur Elise”. This was variously described in letters representing the musical notes (eg ED); the words “the first nine notes of Fur Elise”; and by a musical stave showing the notes. Kist

²³ such as by reference to gas chromatography

²⁴ C-283/01. Decision 27 November 2003

²⁵ None of the member states precluded registration of sound marks; several national laws (Germany, Austria, Spain, France, Germany, Italy and Portugal) specifically allowed for such marks and several were silent (Benelux, Denmark, Finland, Ireland, UK, Sweden).

²⁶ Belgium, Netherlands and Luxemburg.

used the same sounds in relation to similar services to those for which the trade mark was registered.²⁷

The ECJ held that sounds may indeed be registered as trade marks provided that they can be represented graphically, and that the *Sieckmann* criteria should be applied in this regard. The ECJ then turned to a list of questions provided by the Hoge Raad as to what may constitute graphic representation in respect of a sound: musical notes in letter form (DE, as in *Fur Elise*); an “onomatopoeic” written description (by use of a word that sounds similar to what it seeks to describe, for example “Kukelekuuu” for a cockcrow); another written description, for example a sonogram (a three-dimensional diagram of a sound showing time, frequency and intensity); a sound recording attached to the trade mark application form or an on line digital recording (in both cases, this could be a real cock crowing); a combination of these; or anything else.

While this was an understandable attempt by the Dutch court to clarify an area of uncertainty, the ECJ stressed that its role is to answer specific legal questions - not to answer hypothetical questions. Reviewing the initial trade mark applications, the ECJ held that as they had not been made in the form of sonograms, sound recordings or digital recordings, the questions dealing with these could not be answered.

The ECJ did hold that an “onomatopoeic” written description will never be the same as the actual sound imitated, leading to uncertainty as to what is protected by the trade mark. Further, this may be perceived differently, depending on the individual and country in question, this being a particular issue with the imminent addition of new member states. Such a description was therefore, without more, unacceptable. The force of these concerns is exemplified by “Kukelekuuu”; most infant school children in the United Kingdom would describe a cock crow as “cock a doodle do”.

Likewise, the ECJ held that writing notes, (for example ED) is in itself inadequate. This is not sufficiently “clear, precise, self-contained, easily accessible, intelligible, durable and objective” and the pitch and duration, which are essential to define a sound, cannot be determined from the letters alone. For example, is it a high D or a low D, short or long? Is it a funeral march or a polka? However, the ECJ held that representation by a musical stave with bars, clef, notes and rests shows the full pitch and duration and is acceptable.

Accordingly, at least in terms of an actual piece of music, applications for sound trade marks may still be made without difficulty. The position is less clear in terms of more random or imitative noises. It is again submitted, however, that it is perhaps unlikely that many enforcement actions will be raised in respect of such trade marks, because of the difficulty in establishing the use of an identical or similar sound. Those developing sound trade marks would be well advised to prepare the underlying musical stave. Query, however, whether this is in fact any more generally intelligible than a chemical formula for a smell?

²⁷ Both parties were involved in the provision of intellectual property advice services. Kist claimed that the sounds were not signs capable of trade mark registration under the Benelux Trade Mark Law (attacks on trade mark registrations are common in infringement actions). Under this law as amended, there had initially been applications for sound marks, but since a 1999 decision (*Gerechtshofte's Gravenhage* Netherlands 29 May 1999) the Benelux Trade Mark Office generally refused to accept these applications.

5.3 Shapes

Manufacturers often use packaging to distinguish their goods from those of competitors. Packaging is particularly important in respect of beverages, as the product itself cannot be sold alone.

Accordingly, in *Nestle Waters France v OHIM*²⁸ the CFI decided an issue of great importance to the entire beverage industry. This case involved an application for a CTM for a particular three dimensional shape of bottle in relation to non-alcoholic beverages. The description was:

*t[he bottle comprises a main section with, at its base, a recess, in the shape of a slightly truncated cone with, in its flat section, a stylised star in relief. In the lower part of the main section, which is nearly cylindrical from bottom to top, there is an initial series of wavy grooves and, in the upper part, which is of slightly smaller diameter and bobbin-shaped, there are spiralling grooves which form lozenges when seen through the bottle. The top section, which is the shape of a slightly truncated cone, ends in a cylindrical neck with a blue cap.*²⁹

The key issue before the CFI was whether the shape of the bottle was devoid of distinctive character – as such, it could not distinguish the goods from those of any other manufacturer and was therefore incapable of registration. There was also consideration of whether bottles for beverages could have the necessary distinctive character.

OHIM, who had refused to grant the application, argued that the bottle was not distinctive, being made up of common elements and also being, as a whole, a common shape. Nestle argued that the bobbin like upper part of the bottle was distinctive, as were the decorative elements cut into the bottle, which sought to represent “the upper part of a woman’s body draped in a light veil”.

There was also debate about whether distinctiveness should be considered in relation to beverages (in respect of which the trade mark was sought, and which have no inherent shape) or in relation to bottles (on the basis that there may be similar bottles on the market and as such this design was not distinctive).

The CFI held that distinctiveness was to be assessed in respect of the goods or services for which registration was sought – here, non-alcoholic beverages. However, as these goods could not be sold on their own, it was appropriate to consider the distinctiveness of the bottle as a container for beverages. The CFI held that as the drinks market was competitive, if the shape held the consumer’s attention, they were quite capable of perceiving the shape of the packaging as indicative of commercial origin. Thus, bottles for beverages could, in principle, have the necessary distinctive character to be registrable.

In terms of the bottle in question, distinctiveness was to be assessed on the basis of the perception which the general public (as purchasers of non-alcoholic beverages)

²⁸ Case T-305/02. Decision 3 December 2003.

²⁹ <<http://curia.eu.int/jurisp/cgi-bin/form.pl?lang=en&Submit=Submit&docrequire=alldocs&numaff=305%2F02&datefs=&datefe=&nomusuel=&domaine=&mots=&resmax=100>>

had of this bottle, taking into account the presumed expectation of a reasonably well informed, observant and circumspect consumer. Would they perceive it as being indicative of the origin of the beverage, taking into account the overall impression produced by the bottle³⁰ (even if, according to OHIM, some elements of it were common place)? Here, the CFI was satisfied that there was concrete evidence that the bottle was more than the sum of its parts,³¹ was not commonplace and distinguished the beverages inside from those of other manufacturers. Thus, this shape was registrable.

The CFI stressed that the conventional registration criteria³² were to be applied, and that a more stringent test should not be applied to three dimensional marks. This was consistent with previous case law,³³ and rejected OHIM's argument that to be registrable the bottle should be unusual and of arbitrary configuration.

This is a helpful judgment for the beverage industry and also for all those involved in packaging. There will be some elements of packaging which will likely be commonplace. This does not mean that the whole cannot be distinctive. This is also consistent with the approach in relation to more traditional trade marks – phrases and logos may contain common features, but it is a question of whether the whole is distinctive. However, the position of OHIM in the shape cases suggests that further disputes may be likely in relation to the registrability of shapes. As this reluctance does not seem to be mirrored by national trade mark offices, this may be an area for future uncertainty.

5.4 Surname

Finally, in *Nichols plc v Registrar of Trade Marks*, the ECJ Advocate-General³⁴ considered the requirements for registration of surnames, on a reference from the English High Court³⁵.

An application had been made to register “nichols”. The UK Registry had refused the application, applying its long standing practice³⁶ of not registering surnames if they are common (in the sense of appearing 200 times or more in the local telephone directory) and the market of the applicant (for example plumbing) is large, with many competitors. If the market is small, then the UK Registry considered that it was more likely that the average consumer would perceive even a common surname to be capable of distinguishing goods and services of one plumber from those of others. Jacob J³⁷ noted, with approval, that this was because there was a risk of monopoly in

³⁰ Test in Case C-251/95 *SABEL* [1997] ECR I-6191

³¹ Test in Case T-86/01 *Bosch v OHIM (Kit Pro and Kit Super Pro)* [2002] ECR II-4881

³² capable of graphic representation and not devoid of distinctive character

³³ T-88/00 *Mag Instruments (Torch Shape)* [2002] ECR II-467

³⁴ A lawyer, not a judge, who investigates the cases referred to the ECJ and produces an Opinion. This is then considered by the court in preparing the judgment. An Opinion is not binding and is not invariably followed.

³⁵ Case C-404/02, Opinion 15 January 2004

³⁶ As updated in its Practice Amendment Circular No. 6/00 of May 2000

³⁷ as he was then

names, which may be misleading. As a result, the UK Registry assumed that common surnames were devoid of distinctive character,³⁸ unless this was shown to have been acquired.

Jacob J asked the ECJ if a trade mark consisting of a single name could be refused registration as being devoid of distinctive character and, if so, the appropriate principles to be applied in determining this. Jacob J also asked about the relevance of the provision in the Directive that it will not be infringement of a trade mark to use one's own name in accordance with honest practices in industrial and commercial matters.³⁹ In our example of a plumber, this would mean that the existence of a trade mark registration for "Smith" in relation to plumbing services, would not enable the trade mark owner to stop a plumber named Smith trading as "Smith's Plumbers", unless the trade mark owner had a substantial presence in the area, and "Smith's Plumbers" was conducting itself in a way as to suggest a connection with the business of the trade mark owner. Does this restriction on infringement mean that a registration for the surname should be granted, on the basis that it would not in fact give rise to the feared power and attacks on those with the same name? This question was posed on the basis of indications by the ECJ in "*Baby Dry*",⁴⁰ that this restriction on enforcement of the trade mark should be assessed together with the basic registration requirements in considering whether the application should be accepted.

As was seen in relation to shapes, the Advocate General considered that the basic test for registration of a surname was the same as for any other potential trade mark. In particular, he noted that whereas there are some specific exclusions from registration in the Directive,⁴¹ these do not include surnames. He disapproved of the "arbitrary threshold" UK approach, which he considered had no basis in law.

The Advocate General considered the "honest practices" exclusion regarding infringement to be quite separate from issues of registration.⁴² The framework set out required a stringent examination of applications – this must be applied irrespective of difficulties which may arise subsequently regarding infringement.

Accordingly, the Advocate General proposed that the ECJ hold that the key question is whether the consumer would consider that the surname identifies the goods or services of one business rather than others; the fact that it is a frequently occurring name is relevant, but not decisive.

³⁸ and as such incapable of registration, article 3(1)(b) Directive

³⁹ article 6(1)(a) Directive. This is an objective test, to be applied in all the circumstances of the case. See *Vodafone Group plc v Orange Personal Communications Services Ltd* [1997] EMLR 84, *Bayerische Motorenwerke AG v Deenik* (C63/97) [1999] All ER (EC) 235

⁴⁰ *P Proctor & Gamble v OHIM* C-383/99 [2001] ECR I-6251 – when it was held that "Baby Dry" was registrable for nappies as it was not descriptive (a ground for refusal of registration) as it was not a "familiar expression" in "common parlance" in a part of the Community – here, that part using the English language. However, the decision has been largely distinguished and ignored, for example on the basis that the ECJ did not consider that the term was also of distinctive character, thus allowing exclusion from registration of descriptive terms on this basis – see in the UK *CYCLING IS... Trade Mark* [2002] RPC 37

⁴¹ article 3(1)(c) Directive – such as generic terms and geographical origin

⁴² This was in accordance with the pragmatic view expressed by Jacob J, when he stated that he felt that such a use of article 6 would simply involve more disputes, time and expense (although such a situation did seem to be contemplated by "*Baby Dry*").

It is submitted that this is a sensible decision, which will enable relevant factors in the market in question to be taken into account, without creating an unjustified blanket exception to the registration requirements.

6. Conclusion

These recent decisions reveal there is still much to be determined regarding what may be registered, particularly in respect of more innovative trade marks. There also continue to be differences in approach between courts, national offices and OHIM. This has implications for brand owners, brand development, the function of registers of trade marks and European harmonisation of trade mark law and practice.

It is undesirable for all brand owners, who may invest resources in development, for it to be unclear as to whether they will succeed in obtaining a registration, with the benefits that this confers, and for there then to be further uncertainty as to whether the trade mark will be attacked if they try to enforce it. Small businesses, with limited resources, may decide that it is cost effective simply to pursue more conventional paths, leaving larger businesses to continue to try to grow by developing and exploiting innovative brands.

Regarding the registration of more innovative trade marks, the significant factor considered in the cases is the meaning of “graphic representation”. Such trade marks will be different from what is actually recorded with the registries. Is this a problem? Is the focus on graphic representation and accuracy, for example the ECJ’s rejection of the “onomatopoeic” representation in *Shield*, granting undue importance to the registers? What is the function of the registers – purely administrative,⁴³ or is there a wider public function?⁴⁴ In any event, an important aspect of trade mark law and practice is for brand owners, developers and their advisers to be able assess relevant registrations with an element of precision and then apply established legal principles as to the ambit of protection to be conferred by those trade marks. If the registers are not clear, then the resulting uncertainty would mean that the system ceases to fulfil its role.

In this regard, it has been pointed out⁴⁵ that it is infringement to use a sign **similar** to the trade mark.⁴⁶ Accordingly, should precision be required in the initial registration? However, to enable concepts of similarity⁴⁷ to be assessed, there is still a need for basic certainty as to what is registered in the first place. In addition, the above argument constitutes false reasoning, akin to that criticised by the Advocate General in *Nichols* – the consideration of additional elements in infringement⁴⁸ actions does

⁴³ as argued in R Burrell & M Handler, “Making Sense of Trade Mark Law” *IPQ* 2003 **4** 388-410 (“Burrell”)

⁴⁴ The UK Patent Office Charter (the Patent Office also deals with trade marks) states that the aim of the Patent Office is to administer IP legislation fairly and consistently, and to help stimulate innovation and raise the international competitiveness of British industry through intellectual property rights. The Charter can be found on the Patent Office website <www.patent.gov.uk>.

⁴⁵ In Burrell, see footnote 42

⁴⁶ Note also that in the UK, it will defeat a non use application to have used a sign which is not identical to the trade mark – section 46 Trade Marks Act 1994

⁴⁷ and appropriate use

⁴⁸ and validity

not mean that these elements render a less stringent approach appropriate in the initial registration process. Indeed, if this were the case, there would be market place uncertainty, with competitors of a brand owner unclear as to what brands they may be able to develop without fear of infringement. Further, the granting of less defined trade marks to aggressive owners may give them unwarranted power to try to restrain the use of competitive brands, in respect of which, if a more conventional registration approach were adopted, it may be clear to all that there was limited or no infringement risk.

The cases also reveal that national registries, national courts, and OHIM are adopting different approaches to the Directive and the Regulation. Harmonisation is far from having been achieved. However, the ECJ is seeking to address this, and may be said to be taking a pragmatic approach. In the cases considered, the ECJ has focussed on certainty of what is registered, the application of the same criteria to all types of trade marks, unless the legislation provides for a different approach, and minimising confusion with the accession of new member states.

In the future, care will need to continue to be taken in developing brands and preparing applications, particularly regarding more innovative trade marks. Regard should be had not only to national practice, but also to prevailing themes of ECJ decisions and practices in other registries. Otherwise, there is a risk that while some unusual trade marks, or those based on the practice of one registry, may be obtained, that it will be difficult to enforce them, thus decreasing their value.